

REMARKS

This is responsive to the Office Action issued on July 16, 2003. By this response, claims 17, 28, 136, 148 and 149 are amended. No new matter is added. Claims 1-4, 9, 10, 50 and 133 were previously cancelled. Claims 13-16, 27, 40-43 and 54-124 have been withdrawn from consideration. Claims 5-8, 11, 12, 17-26, 28-39, 44-49, 51-53, 125-132 and 134-151 are now active for examination.

The Office Action dated July 16, 2003 allowed claims 5-8, 11, 12, 26, 53, 125, 128-132, 134, 135 and 151. The Office Action rejected claims 17-25, 126 and 136-145 under 35 U.S.C. §102(e) as being anticipated by Hendrix (U.S. Patent No. 6,115,927); claims 28-31, 36, 44-49, 51-52, 127, 146 and 147 under 35 U.S.C. §103(a) as being unpatentable over Hendrix in view of Jackson (U.S. Patent No. 5,724,743), van den Bossche (U.S. Patent No. 6,279,246) and Andersson (U.S. Patent No. 4,726,122). Claim 37 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hendrix, Jackson, van den Bossche, Andersson, and Strege; and claims 148-150 were rejected under 35 U.S.C. §103(a) as being unpatentable over van den Bossche in view of Andersson. Claims 32-35 and 38-39 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The rejections and objection are respectfully traversed in light of the amendment and remarks presented herein.

THE ANTICIPATION REJECTION OF CLAIMS 17-25, 126 AND 136-145 IS TRAVERSED

Claims 17-25, 126 and 136-145 were rejected as being anticipated by Hendrix. By this Response, claims 17 and 136 are amended to include limitations related to target patterns having two dimensional configuration and a handle extending from the target body, positioned and

configured to prevent the target elements from being visually obscured when held by a user. Proper support of the amendment can be found in, for example, Fig. 2 and related descriptions.

Hendrix, however, does not have these features. Therefore, Hendrix cannot support a prima facie case of anticipation. The anticipation rejection is thus untenable and should be withdrawn. Claims 18-25, 126 and 137-145, directly or indirectly, depend on claims 17 and 136, respectively, and incorporate every limitation thereof. Accordingly, the anticipation rejection of claims 18-25, 126 and 137-145 is also untenable based on the same reasons discussed relative to claims 17 and 136, as well as on their own merits. Favorable reconsideration of claims 17-25, 126 and 136-145 is respectfully requested.

THE OBVIOUSNESS REJECTIONS ARE TRAVERSED

Claims 28-31, 36, 44-49, 51-52, 127, 146 and 147 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hendrix in view of Jackson (U.S. Patent No. 5,724,743), van den Bossche (U.S. Patent No. 6,279,246) and Andersson (U.S. Patent No. 4,726,122); claim 37 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hendrix, Jackson, van den Bossche, Andersson, and Strege; and claims 148-150 were rejected under 35 U.S.C. §103(a) as being unpatentable over van den Bossche in view of Andersson. The obviousness rejections are respectfully traversed because the cited references cannot support a prima facie case of obviousness.

After this amendment, claims 28, 146, 148 and 149 require a target system having target patterns arranged in two-dimensional configuration, and a handle extending from the target body, positioned and configured to prevent the target elements from being visually obscured when held by a user.

As pointed out by the Examiner, Hendrix does not describe a target system having target patterns arranged in two-dimensional configuration, and a handle extending from the target body, positioned and configured to prevent the target elements from being visually obscured when held by a user, as required by claims 28, 136, 148 and 149. The Office Action, however, contended that Andersson discloses a handle in Fig. 2, and van den Bossche in Fig. 2 shows a target having two-dimensional target patterns. The Office Action was in the opinion that Hendrix, Andersson and van den Bossche, if combined, purportedly teach every limitation of the claims. Applicants respectfully disagree.

A *prima facie* case of obviousness under 35 U.S.C. § 103 requires three criteria be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation in the references themselves to modify the reference or to combine reference teachings. Third, there must be a reasonable expectation of success for the modification or combination of references. Further, the teaching or suggestion to make the modification or combination of prior art and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The teachings, motivations or suggestions to combine references must be based on objective evidence of record and cannot be resolved on subjective belief and unknown authority. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Additionally, there must be particular finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge to the claimed invention to combine or modify references. *In re Kotzab*, 217 F.3d 1365, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000). The cited references, however, do not meet these requirements.

Andersson depicts in Fig. 2 a target 11 for affixing to a wheel by four attachments 13. A laser beam is projected through the window 19 onto either a plate 14 or 15 (Figs. 2 and 3). A handle 21 is disposed between the window 19 and the plate 15 when the target is utilized in a horizontal position (Fig. 2) or between the window 19 and the plate 14 when the target is utilized in a vertical position (Fig. 3). In either case, when a user holds the target from the handle 21, the user's hand unavoidably would interfere or obscure the laser beam to be projected to the plate 14 or 15. The handle 21 in Andersson is for transporting the target only, and is not held by a user during measurements. Therefore, Andersson does not teach a handle extending from the target body, positioned and configured to prevent the target elements from being visually obscured when held by a user, as required by claims 28, 136, 148 and 149. Therefore, Hendrix, van den Bossche and Andersson, even combined, do not teach every limitation of the claims 28, 146, 148 and 149. Accordingly, the cited references, even combined, cannot support a prima facie case of obviousness. The obviousness rejection is thus untenable and should be withdrawn. Favorable reconsideration of claims 28, 146, 148 and 149 is respectfully requested.

Claim 29-31, 36, 37 44-49, 51-52, 127 and 150, directly or indirectly, depend on claims 28 and 149, respectively, and incorporate every limitation thereof. Thus, claim 29-31, 36, 37 44-49, 51-52, 127 and 150 are also patentable over the references of record based on the same reasons discussed relative to claims 28 and 149, as well as on their own merits. Favorable reconsideration of the claims is respectfully requested.

THE OBJECTION TO CLAIMS 32-35, 38 AND 39 IS ADDRESSED

Claims 32-35, 38 and 39 were objected to for depending on a rejected base claim 28, but would be allowable if rewritten in independent form including all of the limitations of the base

claim and any intervening claims. As discussed earlier, claim 28 is patentable over the references of record. Therefore, claims 32-35, 38 and 39 are also patentable. The claims are now in condition for allowance. Favorable consideration of the claims is respectfully requested.

CONCLUSION

The present application claims subject matter patentable over the references of record and is in condition for allowance. Favorable consideration is respectfully requested. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink that reads "Wei-Chen Chen". The signature is written in a cursive, flowing style.

Wei-Chen. Chen
Recognition under 37 CFR §10.9(b)

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Date: October 16, 2003